



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,708	12/30/1999	IANNE MAE HOWARDS KORITZINSKY	GEMS:0036-1/	8181

7590 10/21/2003
PATRICK S YODER
7915 FM 1960 WEST
SUITE 330
HOUSTON, TX 77070

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

OCT 21 2003

GROUP 3600

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/476,708
Filing Date: December 30, 1999
Appellant(s): KORITZINSKY ET AL.

Brent R. Knight
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 8, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 59, 60, 66, and 68; 61 and 64; 62 and 63; 67; 69 and 71-73; 70; 74, 75, and 76; and 77 and 78 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

Claim 67 contain(s) substantial errors as presented in the Appendix to the brief (being missing altogether). Accordingly, claim 67 is correctly written in the Appendix to the Examiner's Answer.

(9) Prior Art of Record

5,260,999	Wyman	11-1993
5,790,173	Strauss et al.	08-1998
5,852,812	Reeder	12-1998
5,883,985	Pourjavid	03-1999
5,891,035	Wood et al.	04-1999
5,956,483	Grate et al.	09-1999
5,982,917	Clarke et al.	11-1999
6,026,417	Ross et al.	02-2000
6,041,411	Wyatt	03-2000
6,065,136	Kuwabara	05-2000
6,151,696	Miller et al.	11-2000
6,288,799	Sekiguchi	09-2001

Evans, W.S., "Compression via Guided Parsing" (Abstract only), Proceedings [of the] DCC 1998 Data Compression Conference, page 544, edited by Storer, J.A., et al., published by the IEEE Comput. Soc., 1998.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Response to Challenges of Official Notice

Applicant has challenged examiner's takings of official notice.

In rejecting claim 61, the examiner took official notice that it is well known to transmit authorization prompts. This is supported by Strauss et al. (U.S. Patent 5,790,173), column 21, lines 38-55.

In rejecting claim 64, the examiner took official notice that it is well known for indicia to include textual descriptions of programs or products (e.g., catalog entries). This is supported by Grate et al. (U.S. Patent 5,956,483), column 8, line 66, through column 9, line 12.

In rejecting claim 69, the examiner took official notice that it is well known to view lists of products or files that may be ordered, and select the desired item from the list. This is supported by Wyatt (U.S. Patent 6,041,411), column 4, lines 46-52; column 9, lines 29-46; and column 9, line 54, through column 10, line 5.

In rejecting claim 71, the examiner took official notice that it is well known to transmit descriptive data with files or programs. This is supported by Kuwabara (U.S. Patent 6,065,136), column 5, line 63, through column 6, line 12. It is further supported by Sekiguchi (U.S. Patent 6,288,799), Abstract; column 4, lines 47-61; column 9, line 60, through column 10, line 42; column 11, lines 3-19. [Note also Miller et al. (U.S.

Patent 6,151,696), column 14, lines 31-40; and Evans, "Compression via Guided Parsing."]

In rejecting claim 77, the examiner took official notice that it is well known for various devices to be networked to computer workstations. This is supported by Pourjavid (U.S. Patent 5,883,985), column 1, lines 6-9 and 28-34; column 3, lines 38-56; column 5, line 67, through column 6, line 4.

In rejecting claim 78, the examiner took official notice that it is well known for storage devices to be local to remote providers. This is supported by Ross et al. (U.S. Patent 6,026,417), Figure 1A; column 6, lines 53-60.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3625

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 59-64 and 66-68

Claims 59, 60, 66, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) in view of Reeder (U.S. Patent 5,852,812). As per claim 59, Wood discloses a method for providing operational protocols to medical diagnostic systems, the method comprising the steps of: storing a protocol on a machine readable medium, the protocol including at least one operating parameter for a medical diagnostic system (column 2, lines 8-19 and 30-49; column 7, lines 1-43); displaying user viewable indicia descriptive of the protocol at a medical diagnostic location (column 2, lines 8-19 and 30-49; column 7, line 1, through column 8, line 4); and performing a protocol exchange transaction including selecting the protocol via a user interface and loading the protocol at the medical diagnostic location from the machine readable medium via a network connection to the medical diagnostic location (column 6, line 15, through column 8, line 4; Figures 1 and 2). Wood does not disclose storing an accounting record of the transaction, but Reeder teaches doing this (column 14, lines 25-37). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to store an accounting record of the transaction, for the stated advantage of billing users for downloading files (of which protocols are an example).

Wood does not expressly disclose that the user viewable indicia include an exemplary image obtainable via the protocol, but Wood does disclose exemplary images obtainable via the diagnostic system, and presumably via the protocol (column 9, line 67, through column 10, line 43). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the user viewable indicia to include an exemplary image obtainable via the protocol, for the stated advantages of aid in making a diagnosis from images obtained by the diagnostic system, and training new diagnostic system users, and for the obvious advantage of demonstrating what the protocol can do.

As per claim 60, Reeder teaches that the accounting record includes data for invoicing fees associated with downloading a file (column 14, lines 25-42). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the accounting record include data for invoicing fees associated with the protocol, for the obvious advantage of profiting from charging such fees.

As per claim 66, Wood discloses that the user viewable indicia are viewed at a computer workstation coupled to the medical diagnostic system, at least in the sense that the medical diagnostic system includes features which qualify it as being, or including, a computer workstation (Figures 1 and 3; column 3, lines 11-40).

As per claim 68, Wood discloses that the network connection can include the Internet (Abstract; column 7, lines 20-26).

Claims 61 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Reeder as applied to claim 59 above, and further in view of official

Art Unit: 3625

notice. As per claim 61, Wood does not disclose transmitting an authorization prompt to the medical diagnostic location prior to loading the protocol, but official notice is taken that it is well known to transmit authorization prompts. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transmit an authorization prompt to the medical diagnostic location prior to loading the protocol, for the obvious advantage of causing the user to authorize loading the protocol, thus enabling the protocol supplier to charge for loading the protocol, and also avoiding the complaints, ill will, and possible legal liability apt to arise from loading protocols without authorization.

As per claim 64, Wood does not expressly disclose that the user viewable indicia include a textual description of the protocol, although Wood's words at column 7, lines 27-33, and column 7, line 59, through column 8, line 4 are quite suggestive. It appears improbable that a user of Wood's system would download a protocol new to the user with no textual description of the protocol; even in the case of a protocol familiar to the user, a textual description would be helpful for identifying the protocol, distinguishing it from other available protocols, and reminding the user of exactly what it did. In any event, official notice is taken that it is well known for indicia to include textual descriptions of programs or products (e.g., catalog entries). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the user viewable indicia include a textual description of the protocol, for the obvious advantage of enabling the user to conveniently acquire information about the protocol.

Claims 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Reeder as applied to claim 59 above, and further in view of Wyman (U.S. Patent 5,260,999). As per claim 62, Wood does not disclose verifying a service subscription of the medical diagnostic location, the accounting record referencing the subscription, but Wyman teaches verifying a service subscription of a site seeking to use a program (column 6, line 43, through column 7, line 40) an accounting record referencing the subscription (column 7, lines 12-30 in particular). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to verify a service subscription of the medical diagnostic location, and have an accounting record reference the subscription, for the obvious advantages of avoiding providing protocols to users who have not paid for subscriptions, and checking protocols downloaded against subscribers, particularly in the case of what Wyman terms a consumptive style, where a subscription allows only a limited number of downloads.

As per claim 63, Wyman teaches that subscriptions are time-expiring subscriptions (column 27, lines 4-11; note also references to "duration" in Abstract and column 7, lines 3-40). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the subscription verified to include data representative of a time-expiring subscription, for the obvious advantage of avoiding the unwanted giveaway of protocols for which a subscription had expired.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood and Reeder as applied to claim 59 above, and further in view of Clarke et al. (U.S. Patent 5,982,917). Wood discloses that the protocol includes data for filming, viewing,

reconstructing, or processing images (column 2, line 60, through column 3, line 10), but does not quite disclose doing so for images reconstructed from image data; however Clarke teaches data for filming, viewing, reconstructing, or processing images reconstructed from image data (Figures 4, 5, 7, 8, and 9; associated text in columns 5 and 6 describing these figures; column 10, lines 53-67). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have the protocol include data for filming, viewing, reconstructing, or processing images reconstructed from image data, for the stated advantage (see Clarke, Abstract) of enhancing the analysis of images, and thus, for example, better distinguishing malignant from benign masses.

Claims 69-73

Claims 69 and 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) in view of Reeder (U.S. Patent 5,852,812), and official notice. As per claim 69, Wood discloses a method for obtaining an operational protocol for a medical diagnostic system or institution, the method comprising: performing a transaction by accessing data from a protocol library defining the desired protocol via a network link between the diagnostic system or institution and the library, and transmitting the data from the library to the diagnostic system (column 7, lines 1-58). Wood does not expressly disclose ordering a protocol by viewing a protocol list on a user interface at the medical diagnostic system, and selecting a desired protocol from the list, but does disclose referencing preferred presets (protocols) from

an HTML page for retrieval over the Internet or another network (column 7, lines 20-26), which comes close. Moreover, official notice is taken that it is well known to view lists of products or files that may be ordered, and select the desired item from the list. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to order a protocol by viewing a protocol list on a user interface at the medical diagnostic system or institution, and selecting a desired protocol from the list, for the obvious advantage of conveniently learning what protocols are available, and obtaining the most suitable protocol.

Wood does not disclose storing a record of the transaction, but Reeder teaches storing a record of a transaction (the transaction comprising downloading a file; column 14, lines 25-37). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to store a record of the transaction, for the stated advantage of billing users for downloading files, of which protocols are an example.

Wood does not expressly disclose that the protocol list includes an exemplary image obtainable via the protocol, but Wood does disclose exemplary images obtainable via the diagnostic system, and presumably via the protocol (column 9, line 67, through column 10, line 43). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the protocol list to include an exemplary image obtainable via the protocol, for the stated advantages of aid in making a diagnosis from images obtained by the diagnostic system, and training new diagnostic system users, and for the obvious advantage of demonstrating what the protocol can do.

As per claim 71, Wood does not expressly disclose transmitting data descriptive of the protocol to the medical diagnostic system for addition to the protocol list, but official notice is taken that it is well known to transmit descriptive data with files or programs. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to transmit data descriptive of the protocol to the medical diagnostic system, for the obvious advantage of enabling the user to easily determine which protocol was which.

As per claim 72, Wood does not disclose authorizing a fee for the protocol, but Reeder teaches charging a fee for downloading a file (column 14, lines 25-42), from which authorizing a fee is held to be obvious, since attempting to charge people fees which they have in no way authorized would in many cases lead to complaints, refusal to pay, and possible litigation or prosecution. Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to authorize a fee for the protocol, for the obvious advantage of collecting fees without these difficulties.

As per claim 73, Wood discloses that the network link can include the Internet (Abstract; column 7, lines 20-26).

Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood, Reeder, and official notice as applied to claim 69 above, and further in view of the admitted prior art. Wood contains no indication that the protocol list includes protocols for anything except a modality of the medical diagnostic system (ultrasound), from which it is held to be obvious for the protocol list to include only protocols for a modality of the medical diagnostic system. Wood does not disclose that the library includes

Art Unit: 3625

protocols for a plurality of diagnostic system modalities, but it is admitted prior art that there are a plurality of diagnostic system modalities with respective protocols (the instant application, page 1, line 22, through page 2, line 25). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the library to include protocols for a plurality of diagnostic system modalities, for the obvious advantage of enabling users of a plurality of diagnostic systems to obtain suitable protocols.

Claims 74-78

Claims 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035). As per claim 74, Wood discloses a system for providing operational protocols to a medical diagnostic station or institution, the system comprising: at least one storage device for storing data defining a protocol, the protocol including data for controlling operation of the diagnostic station (column 2, lines 8-19 and 30-49; column 7, lines 1-46); a messaging module in the diagnostic station or the institution for formulating messages containing data descriptive of a desired protocol (column 7, lines 20-29); and communications circuitry for establishing a network link between the diagnostic station or institution and a remote protocol provider, for transmitting data descriptive of the desired protocol, and for receiving a reply from the remote protocol provider (column 2, lines 8-19 and 30-49; column 3, line 27, through column 4, line 16; column 7, line 1, through column 8, line 4). Wood does not expressly disclose that the descriptive data include an exemplary image obtainable via the

protocol, but Wood does disclose exemplary images obtainable via the diagnostic system, and presumably via the protocol (column 9, line 67, through column 10, line 43). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the descriptive data to include an exemplary image obtainable via the protocol, for the stated advantages of aid in making a diagnosis from images obtained by the diagnostic system, and training new diagnostic system users, and for the obvious advantage of demonstrating what the protocol can do.

As per claim 75, Wood discloses that the communications circuitry is configured to access the Internet and to transmit the data descriptive of the desired protocol in a message via the Internet (Abstract; column 7, lines 20-29).

As per claim 76, Wood discloses that the messaging module is provided on the medical diagnostic station (column 3, lines 11-38; column 5, lines 42-54; column 7, line 1, through column 8, line 4; Figure 3).

Claims 77 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. (U.S. Patent 5,891,035) and as applied to claim 74 above, and further in view of official notice. As per claim 77, Wood does not expressly disclose that the managing module is provided on a computer workstation networked to the medical diagnostic station within the institution, except in the sense that the medical diagnostic system includes a computer workstation (Figures 1 and 3; column 3, lines 11-40). However, aside from the issue of whether the claim language is met by something networked to itself, official notice is taken that it is well known for various devices to be networked to computer workstations. Hence, it would have been obvious to one of

Art Unit: 3625

ordinary skill in the art at the time of applicant's invention for the computer workstation on which the messaging module is provided to be networked to the medical diagnostic station within the institution, for the obvious advantage of enabling the computer workstation to be used to control the diagnostic equipment, acquire data from the diagnostic equipment, and obtain protocols to be used with the diagnostic equipment, without need for the computer workstation and the diagnostic equipment to be physically joined, a distinct advantage for one wishing to use the computer workstation with several workstations, or to put it to other uses (e.g., word processing) as well as connecting it to medical diagnostic station(s).

As per claim 78, Wood does not expressly disclose that the storage device is local to the remote protocol provider, but neither does Wood suggest that the storage device is not local to the remote protocol provider. Official notice is taken that it is well known for storage devices to be local to remote providers (e.g., disks and other memories in servers). Hence, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention for the storage device to be local to the remote protocol provider, for the obvious advantage of enabling the remote protocol provider to have convenient access to the protocols it was to provide.

(11) Response to Argument

The basic concept of Appellants' invention, loading an operating protocol to a computerized medical diagnostic system from a machine-readable medium via a network, is essentially that of Wood et al. (U.S. Patent 5,891,035). Not all of Appellants'

limitations are disclosed by Wood, but those which are not, are taught by other prior art which is in the same field, or reasonably pertinent to the problem with which Appellants were concerned, as set forth in the claim rejections, above, and in the detailed response, as follows. Therefore, it is held to be proper to reject Appellants' claims.

Issue Number 1

With regard to Issue Number 1, and particularly with regard to claim 59, Appellants argue that the Wood and Reeder references fail to disclose or suggest "displaying user viewable indicia descriptive of the protocol at a medical diagnostic location, wherein the user viewable indicia include an exemplary image obtainable via the protocol," and argue that Examiner's Office action mailed April 1, 2003 admits that Wood does not disclose that the user viewable indicia include an exemplary image obtainable via the protocol. Examiner replies that the essential phrase here is "*via the protocol.*" While it is true and admitted in the final Office Action that Wood does not *expressly* disclose exemplary images obtainable via the protocol, Wood does disclose exemplary images obtainable via the diagnostic system, and presumably via the protocol (column 9, line 67, through column 10, line 43). (It is helpful to note here that "protocol" is Appellants' term for the particular settings of a medical diagnostic apparatus, such as the sequence of pulses used by a Magnetic Resonance Imaging system, or the x-ray settings and gantry movements of a Computerized Tomography system; such a protocol can be a file of data, or a computer program incorporating the appropriate data. Wood uses the term "preset" to describe the same thing, applied to an ultrasound system in particular.) It is not arbitrary to presume that Wood's invention

Art Unit: 3625

involves obtaining an exemplary image through the protocol, since Wood discloses, "Picking an exam category branches the operator to more detailed hierarchies of exams, pathologies, and conditions" (column 10, lines 8-10, emphasis added), and, "The operator can compare the patient's image with the reference image from the library to aid in making a diagnosis of the patient's condition." (column 10, lines 19-22). If this falls short of expressly disclosing the claimed limitation, it is nonetheless highly suggestive. "More detailed hierarchies of exams" suggests that in addition to choosing to view, for example, images of cardiological rather than obstetrical exams, the operator in Wood's system can choose to view images of hearts taken at particular angles, with particular ultrasound settings (for B mode, Doppler, or colorflow; for particular power levels, etc.), so as to compare the image he obtains of a particular patient's heart not only with a reference image of a patient with a similar heart condition, but with a reference image taken under similar conditions.

While Appellants argue that the Wood reference "describes using actual, full images for the purposes of diagnostic treatment, not for an exemplary image obtainable via the protocol," the distinction is not as clear as Appellants may wish to present it as being. Wood does describe using actual, full images, but these actual, full images are exemplary images obtainable via the diagnostic system; Appellants' argument is comparable to asserting that a sweater cannot be red since it is disclosed as being made of wool. As to Appellants' statement that the presets cannot be confused with Wood's reference images, Examiner never supposed or asserted that they were the same things. As to Appellants' statement that the reference images of Wood et al. do

Art Unit: 3625

not present an operator of an ultrasound system with protocol options, Examiner never contended that they did, nor is that a limitation of any of Appellants' claims. The issue is using the protocol options to locate appropriate reference images.

Appellants also write, "The Examiner has repeatedly asserted that the user viewable indicia including an exemplary image is 'well known' to one of ordinary skill in the art . . . However, the Examiner has failed to provide any evidence to support the assertion, as requested by the Appellants." Examiner disputes this account of the prosecution and examination. Examiner took official notice of various features being well known, and, when challenged, provided art to support his takings of official notice, but Examiner did not take official notice or rely on mere assertion that the user viewable indicia including an exemplary image is 'well known' to one of ordinary skill in the art, and most certainly did not do so in rejecting claims 59, 60, 66, or 68, as may readily be verified by reading the claim rejections.

In response to Appellants' argument that Reeder is not analogous art, since it describes an online billing system, and has no necessary relation to medical diagnostic equipment, Examiner replies that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). While Reeder is not in the field of medical diagnostic systems, Reeder is reasonably pertinent to the particular problem with which Applicant was concerned, charging users for downloading files and other usage of a computer

network. It may be observed that Reeder is not, contrary to Applicant's contention, merely directed to an online billing system for exchanging international currency from credit card transactions, but, in Reeder's own words, a billing system for on-line computer networks, where billable events can include access to premium services, file downloads, or gateway connections to other systems (Abstract). Reeder's failure to disclose an exemplary image obtainable via a protocol does not matter, since Reeder was not relied on for that, but for storing an accounting record. Providers of diagnostic device protocols, and exemplary images therefor, like providers of other programs, file downloads, etc., may well wish to be paid for the products they provide. Examiner acknowledges that motivation is required to combine references, but holds that the desire to be paid is generally a strong and obvious motivation for those in business. Therefore, Reeder is believed to be valid and appropriate prior art for storing accounting records.

Appellants refer to their own instant application for teachings regarding the prior art in protocols for medical systems, and especially for the deficiencies of the prior art, but these teachings must be re-evaluated in view of the Wood et al. patent (which was filed substantially before the instant application, but not published as a patent until after Appellants' priority date). Thus, while the instant application teaches that current protocol distribution and update systems fail to include sufficient information on how to execute or implement the protocol, or may require distribution of the protocols by personnel of the service provider, Wood appears to teach sufficient information on how to execute or implement the protocol (see column 2, lines 8-19, for example), and does

Art Unit: 3625

not require distribution of the protocols by personnel of the service provider (see columns 6-8). Appellants in any case leave unclear how this relates to storing accounting records, or the alleged non-obviousness thereof.

Appellants assert that the desire to be paid is not sufficient as a strong and obvious motivation, and describe the Wood and Reeder references (page 13 of the Appeal Brief) in terms which minimize their mutual relevance. Appellants describe Reeder as teaching an online billing system for exchanging international currency for credit card transactions, but do not mention that Reeder teaches that billable events can include "access to premium services, file downloads, or gateway connections to other systems," to quote the Abstract of Reeder's patent. Appellants describe Wood as *merely* (emphasis added) disclosing that an ultrasound system may communicate with a reference library to aid in making a diagnosis of a patient's condition; in fact, Wood discloses that an ultrasound system can download operating protocols/presets from various sources (column 6, line 15, through column 7, line 43). It is not an unreasonable stretch, nor a case of impermissible hindsight reasoning, to combine a system for downloading valuable data with a system for billing for downloads. Therefore, a *prima facie* case of obviousness has been made, and the rejections of claims 59, 60, 66, and 68 should be sustained

Issue Number 2

In addition to repeating their previous arguments regarding the combination of Wood and Reeder, Appellants argue that claims 61 and 64 should be allowable, saying

that the Strauss and Grate references (which were cited in support of Examiner's takings of official notice) are unrelated to medical diagnostic systems and operational protocols for these systems. It is worth reviewing what Examiner took official notice of: in rejecting claim 61, official notice was taken that it is well known to transmit authorization prompts; in rejecting claim 64, official notice was taken that it is well known for indicia to include textual descriptions of programs or products (e.g., catalog entries). These are believed to be standard procedures, very well known, so that it is not necessary for a prior art reference to be specifically in the field of medical diagnostic systems to be "reasonably pertinent to the particular problem with which the applicant was concerned." Since writing was invented, textual descriptions have been widely used in a great variety of areas, including, relatively recently, in indicia of programs and computer files. As Examiner wrote in rejecting claim 64, "It appears improbable that a user of Wood's system would download a protocol new to the user with no textual description of the protocol; even in the case of a protocol familiar to the user, a textual description would be helpful for identifying the protocol, distinguishing it from other available protocols, and reminding the user of exactly what it did." Authorization prompts are not as old as writing, nor quite as well known, but are likely to be quite familiar to computer users. Computers frequently prompt their users with questions like, "Do you want to download this package? Do you want to open this attachment? Do you authorize payment?," and it is held that one of ordinary familiarity with computer technology (and with literacy) would find it obvious to apply to medical diagnostic systems techniques so widely known elsewhere.

Issue Number 3

Appellants argue that Wyman, which was used as a secondary reference in the rejections of claims 62 and 63, is unrelated to medical diagnostic systems and operational protocols for these systems. The issue is similar to that raised by the use of Reeder; the reference is not in the field of medical diagnostic systems, but is held to be reasonably pertinent to the problem with which the applicant was concerned. Wyman teaches verifying a service subscription of a site seeking to use a program, with an accounting record referencing the subscription, and teaches that subscriptions may be time-expiring subscriptions, teachings which are relevant to charging for the use of downloaded programs or files. It is held to be obvious to apply to programs and data files for medical diagnostic systems in particular something as well known and strongly motivated as charging for the information one supplies.

Issue Number 4

Appellants' only explicit argument regarding claim 67 is that Clarke et al. (U.S. Patent 5,982,917) does not cure the alleged deficiencies of the Wood and Reeder references as applied to claim 59. Examiner never argued that it did, not agreeing that Wood and Reeder are deficient as applied to claim 59. Instead, Examiner relied on Clarke to teach filming, viewing, reconstructing, or processing images reconstructed from image data, which was necessary only because, while Wood discloses that the protocol includes data for filming, viewing, reconstructing, or processing images (column 2, line 60, through column 3, line 10), Wood does not quite disclose doing this for

Art Unit: 3625

images reconstructed from image data. Thus, Clarke teaches something quite close to the disclosure of the primary reference, and if the rejection of independent claim 59 is sustained, it is hard to see how claim 67 could plausibly be found allowable.

Issue Number 5

Appellants imply that Examiner acted improperly in observing that Wood comes close to disclosing a limitation recited in claim 69, and observe, "Needless to say, Appellants can find no legal basis for any 'comes close' in the caselaw or Patent and trademark office practice." As Appellants' rhetoric has made it needful to say, Examiner did not rely on "comes close" as the basis for rejecting anything. Instead, after writing, "Wood does not expressly disclose ordering a protocol by viewing a protocol list on a user interface at the medical diagnostic system, and selecting a desired protocol from the list," Examiner merely observed that Wood, "does disclose referencing preferred presets (protocols) from an HTML page for retrieval over the Internet or another network (column 7, lines 20-26), which comes close," after which observation Examiner took official notice that it is well known to view lists of products or files that may be ordered, and select the desired item from the list. It was the official notice which was relied on, not the incidental fact that Wood comes close to disclosing the limitation in question. That Wood "comes close" may make plausible a combination with other prior art which explicitly teaches the element in question, but was never relied on. In response to Appellants' challenge, Examiner cited Wyatt (U.S. Patent 6,041,411) in support.

Appellants next allege that the Wood reference fails to disclose the recited features, making the strange assertion that the system presets that the Examiner asserts to be equivalent to protocols are merely used to prevent the operator from manually setting up a machine, citing Wood, column 7, lines 16-20. More accurately, the presets are used to prevent the operator from *needing* to manually set up a machine. In any event, Wood goes on to write (column 7, lines 27-28), "The browser can be used to download new or specialized user setups from the system manufacturer." It is hard to see on what basis these "presets" or "setups" are to be regarded as not equivalent to Appellants' "protocols."

Appellants argue, "These presets are not described as being in a list or even being associated with an exemplary image." It is true that Wood does not describe the presets as being in a list, although Wood does disclose having presets referenced from an HTML page (column 7, lines 20-26). A plurality of presets on a single HTML page is suggestive of a list, but Examiner, once again, did not rely on this kind of "comes close." Instead, Examiner took official notice, and then cited Wyatt, which is gratifyingly explicit about selecting a particular product from a list of products, where the products may include digital information available to be downloaded. While Appellants are correct that Wyatt does not disclose that an exemplary image is presented in the protocol list, Examiner never relied on Wyatt for that, nor, contrary to Appellants' allegation, did Examiner ever assert that a protocol list obtainable via the protocol is "well known" to one of ordinary skill in the art. Instead, Examiner relied on Wood's teaching of exemplary images obtainable via the diagnostic system, and presumably via the

Art Unit: 3625

protocol. Appellants' accusation that Examiner has failed to provide any evidence to support the assertion is moot, because Examiner has no obligation to support assertions he has never made.

Appellants also argue that the Reeder reference is non-analogous art, and that there is a lack of motivation or suggestion to combine it with Wood. Examiner holds that Reeder is analogous art, as reasonably pertinent to the particular problem with which the applicant was concerned, and that there is proper motivation to combine. As these are essentially the same points that were disputed in Issue No. 1, concerning claim 59, Examiner reiterates his previous arguments.

Issue Number 6

Appellants only briefly treat claim 70, which was rejected on the same basis as claim 69, and further in view of the admitted prior art. Appellants write, "supposed admitted prior art," but it is not a mere supposition that the instant application teaches a plurality of diagnostic system modalities with respective protocols (page 1, line 22, through page 2, line 25). Appellants write that the "admitted prior art" fails to cure the alleged deficiencies Wood, Reeder, and official notice as regards claim 69, which is irrelevant, since Examiner used the admitted prior art to meet the limitations of claim 70, not claim 69. If the rejection of claim 69 is maintained, as Examiner holds that it should be, claim 70 can hardly be found allowable for reciting a feature expressly disclosed by the primary reference (Wood) and one taught by Appellants as admitted prior art.

Issue Number 7

Appellants next address claim 74 and its dependents. Since claim 74 is narrower than the other independent claims, and there is no need to introduce Reeder to meet the limitations, many of the points Appellants raised elsewhere are inapplicable. Appellants argue that Wood fails to disclose or suggest "a messaging module in the diagnostic station or the institution for formulating messages containing data descriptive of a desired protocol, the descriptive data including an exemplary image obtainable via the protocol." Examiner replies that Wood does disclose "a messaging module in the diagnostic station or the institution for formulating messages containing data descriptive of a desired protocol" (column 7, lines 20-29), and Examiner never maintained that Wood expressly discloses that the descriptive data include an exemplary image obtainable via the protocol, only that Wood disclosed exemplary images obtainable via the diagnostic system, and presumably via the protocol (column 9, line 67, through column 10, line 43). Just as a rejection under 35 U.S.C. 103 can properly be made against a claim which is not anticipated by any one prior art reference, provided that several references between them teach the various limitation, and there are valid motivations to combine, it is reasonable to combine features found in a single reference in a way not expressly taught in that single reference, provided that there are valid motivations to make the combination, which Examiner supplies in his rejection of claim 74. It surely cannot be denied that Wood does pertain to medical diagnostic systems.

Appellants write, "Secondly, the Examiner has taken Official Notice regarding features that are alleged to be 'well known' in the art, but has no [sic] provided support

for the Official Notice.” (Page 21 of the Appeal Brief.) Examiner replies that, as the honorable members of the Board can readily confirm, Examiner did not take official notice of anything in rejecting claims 74-76, and did not allege any feature to be “well known” in the art. On page 22, Appellants write, “Specifically, the Examiner has repeatedly asserted that the descriptive data including an exemplary image obtainable via the protocol is ‘well known’ to one of ordinary skill in the art.” Once again, Examiner replies that he did not make any such assertion, and so was under no obligation to provide any evidence of an assertion not made. Accordingly, Examiner respectfully requests the Board to affirm the rejection of claims 74-76.

Issue Number 8

Finally, Appellants argue for the patentability of claims 77 and 78, which depend on claim 74. Appellants argue the Pourjavid and Ross references (U.S. Patents 5,883,985 and 6,026,417, respectively), are not related to providing operational protocols for medical diagnostic systems; Examiner replies that they were not relied upon for anything necessarily specific to providing operational protocols for medical diagnostic systems, but for teaching various devices networked to computer workstations, and storage devices local to remote providers. These references are thus, to recite the legal language once again, reasonably pertinent to the particular problem with which the applicants were concerned; moreover, they are relied upon (in response to challenges of official notice) to teach well-known features of computers and networks. Given that Wood teaches downloading protocols/presets over a network

Art Unit: 3625

using a browser (columns 6 and 7), it is held that one of ordinary skill in the art would find it obvious to combine Wood's disclosure with standard features of computers and computer networks, even in the absence of evidence that these standard features had previously been used in the specific context of networked medical diagnostic systems.

Thus, all claims are held to be properly rejected as unpatentable over Wood (U.S. Patent 5,891,035), which discloses a diagnostic imaging system with data access and communications capacity, in combination with various other prior art of record, which, when not in the field of medical diagnostic systems, is reasonably pertinent to the particular problems with which the applicants were concerned.

For the above reasons, it is believed that the rejections should be sustained.

Appendix

Claim 67 reads as follows:

67. The method of claim 59, wherein the protocol includes data for filming, viewing, reconstructing or processing images reconstructed from image data.

Art Unit: 3625

Respectfully submitted,

Nicholas D. Rosen

Nicholas D. Rosen

October 20, 2003

**NICHOLAS D. ROSEN
PRIMARY EXAMINER**

Conferees:

Wynn Coggins



**WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**

James Trammell



**PATRICK S YODER
7915 FM 1960 WEST
SUITE 330
HOUSTON, TX 77070**